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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,753

07/14/2006

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Q93258

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23373 7590 12/21/2009  
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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

NOTIFICATION DATE

DELIVERY MODE

12/21/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/568,753	<b>Applicant(s)</b> MEBRUER, ROBERT	
	<b>Examiner</b> NATHAN C. UBER	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03 September 2009</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the amendment filed on 08 October 2009.
2. Claim 1 has been amended.
3. Claims 1-6, 8, 10 and 11 are currently pending and have been examined.
4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 October 2009 has been entered.

### Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1-6, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millikan (U.S. 2003/0105667) in view of Williams (U.S. 2002/0049631 A1).

### Claim 1:

Millikan, as shown, discloses the following limitations:

- *a plurality of retail locations each having a detection device for detecting data uniquely related to consumer, in proximity to a location where merchandise is available to the detected consumer, without requiring interaction by the detected consumer (see at least ¶0024, "...a consumer detection and/or identification system...", "...the consumer does not need to do an activity to be detected by the system;" see also at least ¶0021, a retail store; see also at least ¶0027, retrieving unique customer data),*
- *a first processor for generating a plurality of available offers and for identifying in a list specific offers in said plurality of offers that are applicable to a detected consumer based on data stored in a database relating to characteristics of the detected consumer, so that from the plurality of available offers, those specific offers, which relate to the detected consumer based on characteristics of the detected consumer are assembled for presentation as offers specific to the individual consumer (see at least Figure 16, Item 20; see also at least ¶0029, generating targeted advertisements based on the characteristics of the customers identified/detected; see also at least ¶0028 providing individual targeted offers on an individual basis; Examiner notes that in the context of a system, this limitation is directed to a processors *for* accomplishing a task, so *that* a result may occur; hardware components having particular configurations carry patentable weight in system claims, however the intended use of systems or system components do not carry patentable weight in system claims; Examiner has demonstrated where in the prior art Applicant's claimed result is taught, however Examiner recommends that Applicant amend the claim language so *that* the entire limitation carries patentable weight and patentably affects the scope of the claim),*

- *an output device for supplying a single message specific to the individual detected consumer, providing specific offers available to the individual detected consumer in relation to potential purchases at the location* (see at least ¶0033, a PDA or the like possessed by the consumer may receive the offers via a wireless configuration, Examiner notes that the offers and advertisements presented by the Millikan invention are *specific* to the store/location see at least ¶0029, further Millikan discloses that “the message targeting system may perform its operation as described herein with respect to an individual consumer” see at least ¶0028),
- *whereby the detected consumers is able to receive offers at the location without physical interaction on his or her part, and to avail himself or herself of the offers contained in the message supplied at the location* (see at least ¶0026, “...system does not require active participation by the consumer...” ),

With respect to the limitation *a single message*, Millikan does not specifically disclose a single message comprising the targeted offers, although Millikan certainly discloses transmitting a message to a customer via a wireless communication medium as noted in the rejection above. Further Williams discloses a similar system for providing offers to consumers wherein all available offers are provided to customer in a single communication at the POS machine (see at least ¶0057 and ¶0062). However, at ¶0024 Williams discloses that the electronic incentives need not be offered to a customer only at a time of sale and suggests several non limiting examples of how offers may be communicated to consumers including at ¶0034 a Kiosk. Thus, Williams teaches presenting consumer a single message comprising several offers available to the consumer, and when combined with the teaching of Millikan disclosing sending messages including offers to individual customers to a PDA, the combination fully teaches the above limitation. Millikan also does not specifically disclose the following limitations. However, Williams, as shown, discloses the following limitations:

- *a central station, comprising a second processor in communication with the first processor in each of said retail locations and operative to develop for each individual detected consumer a target file of said offers specific to the individual detected consumer and to provide said target file to at least said first processor (see at least figure 1, item, 46; see also at least ¶0033, central system in communication with retail servers that generates specific offers for specific customers identified at the retail location),*
- *the first processor comprises a first server for receiving the target file of offers (see at least figure 1 and ¶0033, IIS),*
- *a second server associated with the location being connected to the first server (see at least figure 1 and ¶0033, CIS),*
- *an Electronic Point of Sale (EPOS) terminal connected with the second server so that offers supplied by said message to a particular consumer are transmitted from the first server to the second server and then to the EPOS terminal so that when a consumer identifies himself or herself at the EPOS terminal, purchases made by the consumer are priced at the EPOS terminal in accordance with said offers specific to and previously supplied to that consumer without any responsive action by the detected consumer prior to presentation at the EPOS terminal other than carriage of goods for purchase to the EPOS terminal (see at least figure 1 and ¶0049, POS receives offer data from CIS and is available to the customer when the customer identifies him/herself at the POS to purchase qualifying items; see also at least ¶0021, no acceptance on the part of the customer prior to qualification is necessary, the customer may accept the offer by purchasing the qualifying product or service),*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the incentive offer processing and networking features of the Williams invention with the in-store offer advertising system of Millikan since Williams

specifically discloses that the Williams invention is designed to be implemented with any communication equipment and information processing equipment already in-place in retail environments (see ¶0045) and since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 2:**

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *said retail location is a retail outlet, a mall, a food court or an event area (see at least ¶0021, "...establishment... such as a retail store...").*

**Claim 3:**

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the detection device comprises a Radio Frequency Identification Device (RFID) reader for reading an RFID tag carried by the consumer to identify a particular consumer (see at least ¶0024, "...detection... system may be a... field generator/detector that is operative to detect an identification card such as a transponder type card or a smart card...", RFID readers are **Inherent** to smart card and transponder technology).*

**Claim 4:**

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the RFID tag can provide a unique code which provides a unique identification of an individual consumer so that individual consumers can be identified and distinguished from one another (see at least ¶0024, "...card may include the consumer information thereon, or provide consumer identification data...").*

**Claim 5:**

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the RFID tag is contained in a card carried by the consumer* (see at least ¶0024, "...an identification card such as a transponder type card or a smart card...").

**Claim 6:**

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the output device comprises a transmitter* (see at least ¶0027, "...a message generator and transmitter..."),
- *for wireless transmission of the message to the individual consumer's mobile telephone or other portable receiver* (see at least ¶0033, "...a wireless configuration... a PDA or the like...").

**Claim 8:**

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Williams, as shown, discloses the following limitation:

- *output device is a printer for printing a document containing the offer* (see at least ¶0022, the benefit may be a printed coupon printed at the POS machine; see also at least ¶¶0057 and 0062, multiple benefits supplied simultaneously to consumer at EPOS),

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features of the Williams invention with the in-store offer advertising system of Millikan since Williams specifically discloses that the Williams invention is designed to be implemented with any communication equipment and information processing equipment already in-place in retail environments (see ¶0045) and since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did



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separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claims 11:**

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further both Millikan and Williams, as shown, disclose the following limitations:

- *the consumer identifies himself or herself by displaying the message to a person at the EPOS terminal, or by swiping a card which contains the user's identifying data at the EPOS terminal (see at least Millikan ¶0032, "...swiping of the customer card..."; see also at least Williams ¶0067, POS system IDs customer via a variety of ID cards).*

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Millikan (U.S. 2003/0105667) in view of Williams (U.S. 2002/0049631 A1) and in view of Eggleston et al. (U.S. 6,061,660).

**Claim 10:**

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Millikan, as shown discloses the following limitations:

- *a retail server, a consumer data base in communication with each of said first processor and said second processor, and operative to provide and consumer data for processing by said first and second processors (see at least ¶0027, storage medium for storing customer data and providing the customer data to the system for generating targeted offers; see also at least ¶0028),*

Millikan does not specifically disclose the following limitation. However, Eggleston, as shown discloses the following limitation:

- *comprising an inventory system in communication with each of said first processor and said second processor, and operative to provide price and inventory for processing by said first and second processors (see at least column 39, lines 12-21, a retailer inventory system is made available to the*

promotion system so that the promotion system can coordinate incentive with the products available/in inventory at the retailer),

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the feature described in the Eggleston invention of polling the retailer's inventory system to coordinate the provision of incentives with the Millikan/Williams inventions that similarly utilize computing technologies in communication over disparate networks since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

#### **Response to Arguments**

9. Applicant's arguments with respect to the claims and the applicability of the secondary references in the previous rejection have been considered but are moot in view of the new grounds of rejection. Examiner addresses Applicants remarks with respect to the primary reference below as the primary reference is maintained in the presented rejection.
10. Applicant argues on page 6 of Applicant's remarks that "Millikan does not suggest transmission of a *single message* containing all offers specific to *an individual consumer...*" While Examiner relies on a secondary reference to teach Applicant's newly claimed "single message," Examiner maintains that Millikan discloses transmitting offers to "an individual customer" in at least ¶0028 in which Millikan discloses "[w]hile the message targeting system may perform its operation as described herein with respect to an individual consumer..." and in at least ¶0033 in which Millikan discloses "[w]hile not specifically shown, a PDA or the like either owned by the consumer or provided by the establishment may also be used on a wireless basis" for the receipt of offers targeted to the consumer by the message targeting system. The combination of references fully discloses and renders obvious Applicant's claimed invention as noted in the rejections above.

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### **Conclusion**

11. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
13. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

14. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/ Examiner, Art Unit 3622  
10 December 2009

/Arthur Duran/  
Primary Examiner, Art Unit 3622